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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,428	02/07/2002	Masaki Nakai	10270.0001/P001	7889

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EXAMINER

OYEBISI, OJO O

ART UNIT	PAPER NUMBER
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3696

MAIL DATE	DELIVERY MODE
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01/22/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/067,428

Applicant(s)

NAKAI, MASAKI

Examiner

OJO O. OYEBISI

Art Unit

3696

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-18, 20-30 and 32-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-18, 20-30, and 32-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/05/08 has been entered. In the RCE filed on 08/05/08, the following have occurred: Claims 1-5, 7-18, 20-30, and 32-38 are pending in the application. Claims 6, 9, and 31 have been cancelled. Claims 1-2, 14-15, and 27 are the only independent claims. Claims 1-2, 4, 7-8, 14-15, 20-21, 27 and 32, have been amended hereby.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 7-18, 20-30, and 32-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Nishimoto (PUB NO.: 2002/0143648).

Re claim 1. Nishimoto discloses an online shopping settlement method comprising: detecting by a communication common carrier an order forwarded from a user terminal

to a Web server providing online shopping services slip (i.e., order data, see fig. 16 element s100, also see paras 0100-0101) and detecting an order confirmation slip that confirms receipt of said order slip forwarded from said Web server to said user terminal (i.e., order confirmation data, see fig. 17 element s200, also see paras 0104-0109), said communication common carrier collecting the price of said online shopping services as communication charges, for transactions for which said order slip and order confirmation slip are prepared, to collect charges that should be paid by said user terminal to said Web server (see fig.19 elements s406, s408, and s410, also see fig.6, also see paras 0110), establishing an account-subscriber table holding a list of the relationship between the account name allocated to said user terminal by said Internet service provider and the subscriber line number of said user terminal (see fig.5); and accessing said account-subscriber table using the account name of said user terminal that connected to the Internet service provider to retrieve the subscriber line number (see paras 0012 and 0014) and then certifying said user terminal that connected to said Internet service provider through checking conditions of said subscriber line (see paras 0101).

Re claim 2. Nishimoto further discloses an online shopping settlement method that is a settlement method for an online shopping system comprising a user terminal, an Internet service provider connected to said user terminal via a network of a communication common carrier providing communication services to said user terminal and a Web server connected to said Internet service provider via the Internet providing online shopping services for said user terminal (see fig. 1), which settlement method

includes: (a) detecting an order slip forwarded from said user terminal to said Web server and the corresponding order confirmation slip for confirming receipt of said order slip forwarded from said Web server to said user terminal (see fig. 16 and 17); (b) recording said order slip and order confirmation slip thus detected (see paras 0012); and (c) wherein said communication common carrier that provides a communication service to said user terminal and collects the price therefor as communication charges, acts as a substitute in respect of a transaction for which the requisite pair of order slip and order confirmation slip are prepared and which transaction is recorded, to collect charges that should be paid by said user terminal to said Web server (see fig. 19 elements s406, s408, and s410, also see fig.6), (d) establishing an account-subscriber table holding a list of the relationship between the account name allocated to said user terminal by said Internet service provider and the subscriber line number of said user terminal (see fig 5); and (e) accessing said account-subscriber table using the account name of said user terminal that connected to the Internet service provider to retrieve the subscriber line number (see paras 0012 and 0014) and then certifying said user terminal that connected to said Internet service provider through checking conditions of said subscriber line (see paras 0101).

Re claims 3, 4-5, and 7. Nishimoto further discloses an online shopping settlement method according to claim 2, which uses a port number for online shopping set for said order slip and order confirmation slip for sending and receiving said order slip and order confirmation slip between said user terminal and said Web server respectively and

wherein (i.e., header. Note the message header usually comprises the port number and the ip addresses of the sending host and the destination host, see fig. 7, 9, 11 and 12) at said step (a) of the settlement method further includes: a packet transferring from said Internet service provider to the Internet with an online shopping port number is detected as being said order slip and a packet coming into said Internet service provider from the Internet with has an online shopping port number is detected as being said order confirmation slip (see fig.16 and 17).

Re claims 8, 9-11. Nishimoto further discloses an online shopping settlement method wherein is also included a step (f) establishing an account-caller table holding a list of the relationship between the account name allocated to said user terminal by said Internet service provider and the calling telephone number of said user terminal (see fig.5), and certifies said user terminal connected to said Internet service provider through checking whether or not the combination of the account name of said user terminal connected to said Internet service provider and the calling telephone number is registered in said account- caller table (see paras 0101)

Re claims 12, 13. Nishimoto an online shopping settlement method that at said step (c) calculates the online shopping charges that should be collected from said user based on said order slip and order confirmation slip recorded at said step (b) and requests payment together with communication charges when invoicing said user terminal for communication charges (see fig.19 elements s406, s408, and s410, also see fig.6)

Re claim 14. Nishimoto further discloses an online shopping settlement system for use

by a communication common carrier that provides a communication service to a user terminal, comprising: order slip monitoring means for detecting an order slip forwarded from said user terminal to a Web server providing online shopping services and detecting a corresponding order. confirmation slip forwarded from said Web server to said user terminal for confirming receipt of said order slip (see fig. 16 and 17), charge collecting means for collecting charges of said online shopping services as communication charges wherein said charge collecting means collects said charges in respect of a transaction for which an order slip and a corresponding order confirmation slip are detected by said order slip monitoring means, to collect charges that should be paid by said user terminal to said Web server (see fig. 19 elements s406, s408, and s410, also see fig.6), an account-subscriber table holding a list of the relationship between an account name allocated to said user terminal by an Internet service provider and a subscriber line number of said user terminal (see fig.5); and a certification means for accessing said account-subscriber table using the account name of said user terminal that is connected to the Internet service provider to retrieve the subscriber line number (see paras 0012 and 0014) and certifying said user terminal that is connected to said Internet service provider through checking conditions of said subscriber line (see paras 0101).

Re claim 15. Nishimoto further discloses an online shopping settlement system that is a settlement system of an online shopping system comprising a user terminal, an Internet service provider connected to said user terminal via a network of a communication common carrier providing communication services to said user terminal and a Web

server connected to said Internet service provider via said Internet which server provides online shopping services to said user terminal (see fig. 1), which settlement system includes: an order slip monitoring means for detecting an order slip forwarded from said user terminal to said Web server and detecting the corresponding order confirmation slip forwarded from said Web server to said user terminal for confirming receipt of said order slip (see fig. 16 and 17); and an order slip recording means for recording said order slip and order confirmation slip detected by said order slip monitoring means (see paras 0012), and a settlement means for collecting charges in substitute that is a means for use by said communication common carrier which means acts as a substitute in respect of a transaction for which said requisite pair of order slip and order confirmation slip are prepared and recorded in said order slip recording means, to collect charges that should be paid by said user terminal to said Web server (see fig.19 elements s406, s408, and s410, also see fig.6), an account-subscriber table holding a list of the relationship between an account name allocated to said user terminal by said Internet service provider and a subscriber line number of said user terminal (see fig.5), and a subscriber certification means that receives from said Internet service provider the account name of said user terminal that is connected to said Internet service provider, accesses said account-subscriber table and retrieves the appropriate subscriber line number and through checking the condition of that subscriber line (see paras 0012 and 0014), certifies said user terminal is connected to said Internet service provider (see paras 0101).

Re claims 16, 17-18, and 20. Nishimoto further discloses an online shopping settlement system wherein the configuration is such that a port number for online shopping especially set for said order slip and order confirmation slip is used, facilitating the sending and receiving of said order slip and order confirmation slip between said user terminal and said Web server (i.e., header. Note the message header usually comprises the port number and the ip addresses of the sending host and the destination host, see fig. 7, 9, 11 and 12), and wherein said order slip monitoring means provides a means for detecting those packets among packets going out from said Internet service provider to the Internet which have an online shopping port number as being an order slip and detecting those packets among packets coming into said Internet service provider from the Internet which have an online shopping port number as being an order confirmation slip (see fig. 11, 12, 16 and 17)

Re claims 21, 22-24. Nishimoto further discloses an online shopping settlement system according to that provides an account-caller table holding a list of the relationship between the account name allocated to said user terminal by said Internet service provider and the calling telephone number of said user terminal (see fig.5), and that provides a subscriber certification means that receives from said Internet service provider, the account name of said user terminal that connected to said Internet service provider and the calling telephone number, and through checking whether or not the combination of the account name of said user terminal connected to said Internet service provider and the calling telephone number is registered in said account-caller table, certifies said user terminal that connected to said Internet service provider (see paras 0101, 0012,

and 0014).

Re claims 25, 26. Nishimoto further discloses an online shopping settlement system wherein said settlement means provides a means for calculating the online shopping charges that should be collected from said user based on said order slip and order confirmation slip recorded by said order slip recording means and requests payment together with communication charges when invoicing said user terminal for communication charges (see fig.19 elements s406, s408, and s410, also see fig.6)

Re claim 27. Nishimoto further discloses an online shopping settlement program operating a computer forming a settlement system of an online shopping system that includes a user terminal, an Internet service provider connected to said user terminal via a network of a communication common carrier providing communication services to said user terminal and a Web server connected to said Internet service provider via the Internet which server provides online shopping services to said user terminal, such that said computer functions as: an order slip monitoring means for detecting an order slip forwarded from said user terminal to said Web server and detecting the corresponding order confirmation slip forwarded from said Web server to said user terminal for confirming receipt of said order slip (see fig. 16 and 17); an order slip recording means for recording said order slip and order confirmation slip detected by said order slip monitoring means (see paras 0012); and a settlement means for collecting charges in substitute that is a means for use by said communication common carrier which means acts as a substitute in respect of a transaction for which the requisite pair of orderslip and order confirmation slip are prepared and recorded in said order slip recording

means, to collect charges that should be paid by said user terminal to said Web server (see fig. 19 elements s406, s408, and s410, also see fig.6), an establishing means for providing an account-subscriber table holding a list of the relationship between an account name allocated to said user terminal by said Internet service provider and a subscriber line number of said user terminal (see fig.5), and a subscriber certification means that receives from said Internet service provider the account name of said user terminal that is connected to said Internet service provider, accesses said account-subscriber table and retrieves the appropriate subscriber line number and through checking the condition of that subscriber line (see paras 0012 and 0014), certifies said user terminal is connected to said Internet service provider (see paras 0101).

Re claims 28, :29-30. Nishimoto further discloses an online shopping settlement program facilitating a configuration wherein a port number for online shopping especially set for said order slip and order confirmation slip is used, facilitating the sending and receiving of said order slip and order confirmation slip between said user terminal and said Web server (i.e., header. Note the message header usually comprises the port number and the ip addresses of the sending host and the destination host, see fig. 7, 9, 11 and 12), and facilitating said order slip monitoring means providing a means for detecting those packets among packets going out from said Internet service provider to said Internet which have an online shopping port number as being an order slip and detecting those packets among packets coming into said Internet service provider from said Internet which have an online shopping port number as being an order confirmation slip (see fig. 11, 12, 16 and 17).

Re claims 32. Nishimoto further discloses an online shopping settlement program facilitating operations such that said subscriber certification means provides an IP-subscriber table that stores the relationship between the IP address allocated to said user terminal from said Internet service provider and said subscriber line number while said user terminal is connected to said Internet service provider, and facilitating operations such that said order slip recording means does not record an order slip from among those order slips detected by said order slip monitoring means for which the subscriber line number corresponding to the source IP address is not registered in said IP-subscriber table and does not record an order confirmation slip from among those order confirmation slips detected by said order slip monitoring means for which the subscriber line number corresponding to the IP address of said user terminal that is the destination is not registered in said IP-subscriber table (see fig5)

Re claims 33-36. Nishimoto further discloses an online shopping settlement program facilitating operations such that said subscriber certification means provides an IP-subscriber table that stores the relationship between the IP address allocated to said user terminal from said Internet service provider and said subscriber line number while said user terminal is connected to said Internet service provider (see fig.5), and facilitating operations such that said order slip recording means does not record an order slip from among those order slips detected by said order slip monitoring means for which the subscriber line number corresponding to the source IP address is not registered in said IP-subscriber table and does not record an order confirmation slip from among those order confirmation slips detected by said order slip monitoring means

for which the subscriber line number corresponding to the IP address of said user terminal that is the destination is not registered in said IP-subscriber table (see paras 0071-0072).

Re claims 37 and 38. Nishimoto further discloses an online shopping settlement program facilitating operations such that said settlement means provides a means for calculating the online shopping charges that should be collected from said user based on said order slip and order confirmation slip recorded by said order slip recording means and requests payment together with communication charges when invoicing said user terminal for communication charges (see fig. 19 elements s406, s408, and s410, also see fig.6).

Response to Arguments

Applicant's arguments filed 11/05/08 have been fully considered but they are not persuasive. The applicant argues in substance that the primary reference, Nishimoto, fails to disclose the language of claim 1 i.e., "accessing said account-subscriber table using the account name of said user terminal that is connected to the Internet service provider to retrieve the subscriber line number and then certifying said user terminal that is connected to said Internet service provider through checking conditions of said subscriber line." Contrary to the applicant's assertion, Nishimoto teaches "accessing said account-subscriber table using the account name of said user terminal that is connected to the Internet service provider to retrieve the subscriber line number." (i.e., When the user enters the article information into the user's terminal such as a mobile telephone, the entered article information and the ESN stored in the user's terminal are

sent to the online shopping apparatus. The online shopping apparatus retrieves the user's name and destination, which are stored in advance and correspond to the ESN, and prepares the user information for sending them to the terminal of the online shopping dealer. The online shopping dealer performs processing for sending the article selected by the user to the destination based on the received article information and the user information, see paras 0014). The examiner asserts that the online shopping apparatus, taught by Nishimoto, accesses the internal database to retrieve the pre-stored user's name and destination which is akin to applicant's claimed limitation of "accessing said account-subscriber table using the account name of said user terminal that is connected to the Internet service provider to retrieve the subscriber line number." Nishimoto further discloses "certifying said user terminal that is connected to said Internet service provider through checking conditions of said subscriber line." (i.e., The user of mobile telephone 200 views a catalog or the like for online shopping, and determines the article number of the article, which the user intends to purchase. The user of mobile telephone 200 enters the determined article number and the quantity via console 252 of mobile telephone 200. The user of mobile telephone 200 requests via console 252 the sending of the order data to server 100. Mobile telephone 200 reads out the identification number stored in storing portion 240, and sends the order data (FIG. 7) including the identification number and the telephone number to server 100. When server 100 receives the order data (FIG. 7) from mobile telephone 200 (YES in S100), server 100 reads out the user ID from the user database (FIG. 5) based on the identification number included in the received order database. If

the user in question is already registered (YES in S104), the name and address of the user, who sent the order data, are read out from the user database (FIG. 5) based on the identification number (S108). Server 100 prepares transfer data (FIG. 8) based on the read name and address of the user (S110), and sends the transfer data (FIG. 8) to computer 300 of the online shopping dealer (S112), see paras 0100-0101). The process, taught by Nishimoto supra, of verifying that the subscriber/user is registered with the service provider by checking the subscriber's name and address in the database is akin to applicant's claimed limitation of "certifying user terminal that is connected to said Internet service provider."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571)272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571)272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/OJO O OYEBISI/
Examiner, Art Unit 3696

Application Number**Application/Control No.**

10/067,428

**Applicant(s)/Patent under
Reexamination**

NAKAI, MASAKI

Examiner

OJO O. OYEBISI

Art Unit

3696